

REMARKS

I. Formalities

Claims 1-22 have been elected herein, with traverse.

II. Response to the Restriction Requirement

A restriction of Applicants' claims was required under 35 U.S.C. §121 for the following groups of claims:

I. Claims 1-22, drawn to a semiconductor device, classified in class 257, subclass 704; and

II. Claims 23-28, drawn to a process of making a semiconductor device, classified in class 438, subclass 125.

As required by the Office Action, Applicants provisionally elect, subject to a traverse that follows hereafter, to prosecute the semiconductor device claims of Group I, i.e., claims 1-22.

Applicants agree that the claims of Group I concern semiconductor devices and that the claims of Group II concern processes for making semiconductor devices. However, Applicants traverse the subject restriction requirement on the grounds that it fails to comply with the express language of 35 U.S.C. §121, which states that a restriction is only proper between claims that are both "independent and distinct." The Office Action alleges that restriction is required because the invention of Applicants' claims are "distinct." However, it has not been alleged that Applicants' claimed invention is "independent and distinct," and yet this requirement is a prerequisite under the Patent Statutes before the Commissioner's discretion may be exercised under 35 U.S.C. §121.

Furthermore, it is respectfully pointed out that the subject restriction requirement *prima facie* fails to comply with the requirement of MPEP 806.05(e), which states that the test for distinctness requires either:

(1) that the process *as claimed* can be practiced by another materially different apparatus or by hand; or

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(2) that the apparatus *as claimed* can be used to practice another and materially different process.

Applicants respectfully submit that the words "as claimed" were not taken into consideration when determining the restriction requirement.

Furthermore, it is respectfully pointed out that the subject restriction requirement *prima facie* fails to comply with the requirement of MPEP 806.05(f), which states that the test for distinctness requires either:

(1) that the process *as claimed* is not an obvious process of making the product and the process *as claimed* can be used to make other and different products; or

(2) that the product *as claimed* can be made by another and materially different process.

Applicants respectfully submit that the words "as claimed" were not taken into consideration when determining the restriction requirement.

In an effort to justify the Restriction Requirement, it is alleged that the Group I and II inventions are distinct because the device of the Group I invention could be made by processes materially different from those of the Group II invention. It is respectfully submitted that the claims are sufficiently definite so that there should be no question as to what is being claimed. There is no reason for attempting to read limitations into the claims that are not set out therein. It is respectfully submitted that it is improper to base a Restriction Requirement upon conjecture of what could be called for in Applicants' claims.

In a further effort to justify the Restriction Requirement, it is alleged that the Restriction Requirement is proper because different classifications have been shown. However, it is strenuously urged that the alleged different Patent Office classifications of Applicants' claims cannot and should not be relied upon as the basis for a Restriction Requirement. It is a well-known fact that, in the interest of administrative efficiency, the prior art in the Patent Office is reclassified on a continuing basis. Thus, a given group of claims might be classified identically one day only to be classified separately the next day due to a Patent Office reclassification project. It is respectfully submitted that Congress never intended (by enacting 35 U.S.C. §121)

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that the jurisdictional requisite of "independent and distinct" depend upon and vary in accordance with Patent Office reclassification programs. To suggest otherwise would be to suggest that Congress enacted 35 U.S.C. §121 with the intent that the jurisdiction of the Commissioner in restriction matters could be enlarged by the Commissioner himself, and this clearly would be improper on Constitutional grounds.

Furthermore, maintaining the Restriction Requirement and forcing Applicants to file a divisional application to include the non-elected claims only serves to increase the workload upon the U.S. Patent and Trademark Office and to increase the expenses incurred by Applicants. Accordingly, maintaining the present Restriction Requirement does not benefit anyone.

Also, it is noted that restriction is never mandatory and is discretionary under 35 U.S.C. 121 only when "two or more independent and distinct" inventions are claimed. It is respectfully submitted that the restriction requirement should be removed because there is not even alleged a valid ground under 35 U.S.C. 121 for exercising the Commissioner's discretion in requiring the restriction.

Therefore, it is respectfully submitted that the Restriction Requirement should be removed because there has not been alleged a valid ground under 35 U.S.C. §121 for exercising the Commissioner's discretion and requiring the restriction. Although the provisional election of the claims of Group I, i.e., claims 1-22, is affirmed, the Restriction Requirement is respectfully traversed, and reconsideration and withdrawal of the requirement for restriction is respectfully requested.



CONCLUSION

No fees are believed to be due with this Response. However, the Commissioner for Patents is hereby authorized to charge any fees due by reason of this paper, or credit any overpayment, to Account No. 02-4467.

If there are matters that can be discussed by telephone to further the prosecution of this application, Applicants invite Examiner Mai-Huong C. Tran to call the undersigned attorney at the Examiner's convenience.

Respectfully submitted,

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